

### **REMARKS**

Claims 1-20 are pending in this application. Claims 1-7, 16-18, and 20 stand rejected and claim 8 is objected to. Applicant wishes to thank the Examiner for the indication of allowance of claim 19, and the indication of allowable subject matter in claim 8. In light of the remarks set forth below, Applicants respectfully submit that each of the pending claims is in immediate condition for allowance.

Claims 1-7, 17, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2001/0032269 ("Wilson"). Applicants respectfully request reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicants.

Among the limitations of independent claims 1, 17, and 19 not present in Wilson is a buffering controller for buffering a received packet for a set time period before forwarding it so that a receiving time interval of packets at the second computer has minimum variation to a sending time interval of packets at the first computer. In other words, the claimed repeater comprises a buffering controller that buffers a received packet for a set time period before forwarding it. In this manner, the receiving time interval of packets at the second computer has minimum time variation to a sending time interval of packets at the first computer. This feature is not disclosed

anywhere in Wilson nor is it inherent in Wilson, contrary to the assertion in the Office Action.

The Office Action admits that “when reviewing Wilson, it may not be explicitly disclosed that the buffer buffers a packet for a set time. However, based on what Wilson does teach, it can be concluded/anticipated that the buffer of Wilson must buffer the received packet for a set time period for optimal system performance.” See Office Action at 5.

While Wilson discloses a buffer, there is no teaching in Wilson that a buffering controller buffers a received packet for a set time period before forwarding it so that a receiving time interval of packets at the second computer have a minimum variation to a sending time interval of packets at the first computer. In Wilson, when the buffer level nears capacity, data packets are sent to target switches marked by the sending switch to indicate possible congestion. Marking data packets based on congestion is unlike Applicants’ explicitly recited buffer controller for buffering for a set time period before forwarding.

The Office Action asserts that a buffer holds only so much data. If more data arriving into a buffer than going out of the buffer, a buffer overflow will occur. Similarly, if there is more data leaving the buffer than arriving into the buffer, a buffer underflow will occur. Wilson’s system adjusts the transfer rate of data packets propagated through the buffer to prevent these two scenarios from occurring. However, this does not disclose Applicants’ buffer controller and its designated functions.

In Wilson, the transfer rate may be adjusted to utilize the full capacity of a transmission medium. See paragraph 47. However, this does not disclose Applicants’ explicitly recited limitations and Applicants’ limitations are not inherent in Wilson. Therefore, Applicants respectfully request reconsideration and withdrawal of this rejection.

Applicants' claims are not inherently described by Wilson. As set forth in the M.P.E.P., a rejection under 35 U.S.C. § 103 can be made when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic. See M.P.E.P. § 2112. However, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). In order to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." See In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (Disclosure in the prior art of two fastening elements that could perform the same function as the three fastening elements in the claims did not disclose a separate third fastening element, either expressly or inherently). In addition, when "relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood

vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.

In In re Schreiber, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997), the court affirmed a finding that a prior patent to a conical spout used primarily to dispense oil from an oil can inherently performed the functions recited in applicant's claim to a conical container top for dispensing popped popcorn. The examiner had asserted inherency based on the structural similarity between the patented spout and applicant's disclosed top, i.e., both structures had the same general shape. The court stated:

[N]othing in Schreiber's [applicant's] claim suggests that Schreiber's container is of a 'different shape' than Harz's [patent]. In fact, [ ] an embodiment according to Harz (Fig. 5) and the embodiment depicted in Fig. 1 of Schreiber's application have the same general shape. For that reason, the examiner was justified in concluding that the opening of a conically shaped top as disclosed by Harz is inherently of a size sufficient to 'allow [ ] several kernels of popped popcorn to pass through at the same time' and that the taper of Harz's conically shaped top is inherently of such a shape 'as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted to the container.' The examiner therefore correctly found that Harz established a prima facie case of anticipation.

See In re Schreiber, 128 F.3d at 1478, 44 USPQ2d at 1432.

In the present case, the prior art and the claimed subject matter are neither identical or substantially similar to each other. Applicants explicitly recite a buffering controller for buffering a received packet for a set time period before forwarding it so that a receiving time interval of packets at the second computer has minimum variation to a sending time interval of packets at the first computer. This feature is not inherent in Wilson's system where a sending host is configured to send packet traffic at a set rate. Wilson's system includes a sending switch for receiving the packet traffic. The sending switch includes an input buffer for receiving the packet traffic at the set rate where the input buffer is actively monitored to ascertain a capacity level. The sending host monitors acknowledgment packets and adjusts the set rate based on whether the acknowledgment packets are marked with the congestion indicator. In a further example, the set rate is decreased every time one of the marked packets is detected and increased when no marked packets are detected per round trip time. See Abstract.

In Wilson, the sending TCP host time stamps each data packet in computer memory and compares the time stamp of the sent data packet to the time when the acknowledgment is received for the data packet. During the round trip time (RTT), the sending host sends the number of packets allowable by the congestion window (CWND). The CWND is a congestion window that limits the amount of data that can be transmitted into a transmission media before receiving an ACK. Therefore, the sending TCP host keeps track of the sent data packets and waits for a round trip time to be completed for each of the data packets. The sending TCP host waits to receive the ACK for the data packet and decreases the data transmission rate when the data packet is marked (meaning congestion exists). If, during a full RTT, none of the data packets are marked (no congestion exists), the rate of data transfer is increased. If none of the data packets were marked during a RTT, the data transfer rate is increased by one packet per round trip time. Data packet transfer is managed so data packet dropping is reduced while at the same time increasing the maximum data throughput by using the congestion control protocol. See Paragraphs 47-48.

Wilson varies data packet transfer rates base on network congestion. Buffer operations that limit overflow and underflow are not disclosed in Wilson and are inapplicable to Applicants' buffer controller. There is no disclosure of a buffering controller for buffering a received packet for a set time period before forwarding it so that a receiving time interval of packets at the second computer has minimum variation to a sending time interval of packets at the first computer. As such, Applicants' claimed buffer controller is not inherent in Wilson.

Applicants have responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: October 18, 2005

Respectfully submitted,

By 

Ian R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN & OSHINSKY  
LLP

1177 Avenue of the Americas  
New York, New York 10036-2714  
(212) 835-1400  
Attorney for Applicants

IRB/mgs